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| 10/666,405 | 09/15/2003 | Wen Jen Yuan | | 7454 |

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EXAMINER

JULES, FRANTZ F

| ART UNIT | PAPER NUMBER |
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3617

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/666,405

Applicant(s)

YUAN, WEN JEN

Examiner

Frantz F. Jules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 1-11 are objected to because of the following informalities:

In claim 1, line 13, the phrase "the car wheel" should be changed to —a car wheel—to improve the clarity of the claim language.

Appropriate correction is required.

Claims 2–11 are objected as being dependent upon objected base claim 1.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recitation of "a bushing formed in a central portion of the housing bottom" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

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per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, lines 3-4, the phrase "a bushing formed in a central portion of the housing bottom" is confusing as it unclear what particular structure applicant is referring to by a housing bottom. The drawing identifies a bushing positioned on the center of the housing and this is located only on the interior of the housing. The claim also calls for a front rim which is located within an interior confined by the housing and the cover.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Kim (US 6,637,831).

Claims 1-5

Kim discloses an emblem means comprising a housing (8) secured in a central portion of a wheel disc of a car wheel, a rotating disk (3) rotatably coupled with said housing about a shaft (5) formed in a central axial portion of said housing, with said shaft having an axis defined at a shaft center and coaxially aligning with an axle axis of the car wheel; a pendulum weight (9) formed on a lower portion of said rotating disk; and a decorative feature (4) including emblem, logo, trademark, figure and design formed on a front surface of said rotating disk; whereby upon rotation of said housing along with the rotation of a car wheel when driving a car, said rotating disk is gravitationally pendent to constantly orient said decorative feature in an upright position for a clear display thereof without being simultaneously rotated with the car wheel and the housing.

The housing is secured in a recess formed in a central portion of said wheel disk in accordance with claim 2.

The rotating disk further includes a decorative piece having said decorative feature formed thereon and fixed on a front surface portion of the rotating disk as disclosed in col 3, lines 3-4, and a transparent cover combined with the housing to encase the rotating disk and the decorative piece within the housing as disclosed in col 3, lines 31-32 in accordance with claim 3.

The decorative piece is formed as a sticker adhered on a front surface of the rotating disk or by directly printing the decorative features on a front surface of the rotating disk in accordance with claims 4-5.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US 6,637,831) as applied to claim 1 and in view of Lalonde (US 4,388,771).

Claim 6

Kim teaches all of the limitations of claim 6 except for an emblem means wherein said decorative piece and the rotating disk are integrally formed as a decorative rotating disk. The general concept of forming integrally a rotating disk and a decorative piece is well known in the art as illustrated by Lalonde which disclose the teaching of printing information directly on a rotating disk thereby forming a decorative rotating disk. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kim to include the use of forming integrally a decorative piece and a rotating disk in his advantageous emblem means as taught by Lalonde in order to eliminate the risk of removal of the decorative piece due to moisture accumulation inside of the housing.

Claims 10-11

Kim teaches all of the limitations of claims 10-11 except for an emblem means wherein said rotating disk includes a hollow portion formed in a

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convex portion formed on a lower portion of the rotating disk and is being filled with filler liquid to serve as the pendulum weight. The general concept of forming "a hollow portion formed in a convex portion formed on a lower portion of the rotating disk and is being filled with filler liquid to serve as the pendulum weight" is well known in the art as illustrated by Lalonde which disclose the teaching of forming "a hollow portion formed in a convex portion formed on a lower portion of the rotating disk (24) and is being filled with filler liquid to serve as the pendulum weight", see col 3, lines 35-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kim to include the use of forming "a hollow portion formed in a convex portion formed on a lower portion of the rotating disk and is being filled with filler liquid to serve as the pendulum weight" in his advantageous emblem means as taught by Lalonde in order to reduce the number of components used on the rotating disk.

Allowable Subject Matter

9. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 8-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Lee et al, Gray, Goodman, Harlen, and Defreitas are cited to show related wheel cover comprising non-rotating display device.

Fretisch is cited to show a decorative sign attached to a structure of a vehicle thru adhesive.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (703) 308-8780. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Frantz F. Jules
Examiner
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FFJ

June 8, 2004

**FRANTZ F. JULES
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'Frantz F. Jules', written over a horizontal line.